

REMARKS

Claims 1-7, 9-10, 12-21, 23, 25, and 27-30 are pending in the application. Claims 1, 14, 23, and 27 are independent. By the foregoing Amendment, Applicants have amended claims 1, 9-10, and 12-18 and canceled claims 8, 11, 22, and 26. These changes are believed to introduce no new matter and their entry is respectfully requested.

Provisional Rejection of Claims 1-23 and 25-30 Under Obviousness-Type Double Patenting

In the Office Action, the Examiner provisionally rejected claims 1-23 and 25-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending U.S. Application No. 10/302,281 (hereinafter “‘281 application”). Applicants respectfully traverse the rejection. Because this is a provisional rejection, Applicants respectfully await the actual outcome of the prosecution of the ‘281 application.

Rejection of Claims 1-8 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1-8 under 35 U.S.C. §103(a) as being obvious over U.S. Publication No. 2003/0229694 to Tsai et al. (hereinafter “*Tsai*”) in view of U.S. Patent No. 7,100,031 to Reasor et al. (hereinafter “*Reasor*”). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited references teach each and every element of the claimed invention. (MPEP §2143.) *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). A patent composed of several elements is not proven obvious merely by demonstrating that each of its elements was independently known in the prior art. *KSR Int’l C. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). If a combination or modification to a reference is used, an Examiner must show that there is some expectation of success that the combination or modification proffered would predictably result in the claimed invention. Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the U.S. Supreme Court in *KSR* include the *Graham* factors of determining the scope and content of the prior art, ascertaining the differences

between the claimed invention and the prior art, and resolving the level of ordinary skill in the pertinent art.

Once the *Graham* factual inquiries are resolved, the Examiner must explain why the difference(s) between the cited references and the claimed invention would have been obvious to one of ordinary skill in the art. The rationale used must be a permissible rationale. The USPTO promulgated Examination Guidelines for Determining Obviousness in View of *KSR* in the Federal Register, Vol. 72, No. 195 (October 10, 2007). These *KSR* Guidelines enumerate permissible rationales and the findings of fact that must be made under the particular rationale.

Applicants respectfully submit that the Examiner has failed to show that *Tsai* in view of *Reasor* teaches each and every element of claim 1. Claim 1 recites in pertinent part “receiving a request to ***provide an indication of at least one protocol that is available*** to be used to perform a task on a remote computer; receiving an instruction to ***perform the task using the protocol***, the instruction including a request to access firmware of the remote computer using a remote firmware interface of a caller computer on a network, the remote firmware interface operating in accordance with an Extensible Firmware Interface (EFI) framework standard, wherein the task is to call a pre-defined function of firmware of the remote computer; determining that the task is to call a pre-defined function of firmware of the remote computer, the pre-defined function being a protocol interface function; executing the task at the remote computer using the protocol independent of an operating system of the remote computer; and sending a response to the calling computer indicating that the task is completed” (emphasis added). Support for these changes can be found in paragraphs [0033] – [0039] of Applicants’ Specification.

Applicants respectfully submit that *Tsai* in view of *Reasor* fails to teach each and every element of the claimed invention. For example, *Tsai* in view of *Reasor* fails to teach using a caller computer to interrogate a remote computer to determine whether there are different protocols on the remote computer that are available to perform a particular task. *Tsai* in view of *Reasor* also fails to teach instructing the remote computer to perform the task using the protocol. *Tsai* in view of *Reasor* specifically fails to teach instructing the remote computer to perform a protocol interface function using the protocol. *Tsai* does not appear to interrogate its “working

computer” to determine available protocols for performing tasks. Likewise this element is missing from *Reasor*. Because *Tsai* in view of *Reasor* fails to teach each and every element of claim 1 Applicants respectfully submit that claim 1 is patentable over claim *Tsai* in view of *Reasor*.

Claims 2-8 properly depend from claim 1. Accordingly, Applicants respectfully submit that claims 2-8 are patentable for at least the same reasons that claim 1 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 1-8.

Rejection of Claims 9-23 and 25-30 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 9-23 and 25-30 under 35 U.S.C. §103(a) as being obvious *Tsai* in view of *Reasor* in further view of U.S. Patent No. 5,715,387 to Barnstijn et al. (hereinafter “*Barnstijn*”). Applicants respectfully traverse the rejection.

Applicants respectfully submit that *Tsai* in view of *Reasor* in further view of *Barnstijn* fails to disclose each and every element as recited in independent claims 14, 23, and/or 27. Representative amended claim 14 recites in pertinent part “processing a request packet received from a caller computer at a remote computer over a network, the request packet including a ***request to provide an indication of at least one protocol that is available to be used to perform a task on a remote computer***; processing an instruction received from the caller computer to perform the task using the protocol, the instruction including a request to access firmware of the remote computer using a remote firmware interface of the caller computer on a network, the remote firmware interface operating in accordance with an Extensible Firmware Interface (EFI) framework standard, wherein the task is to call access a memory address of the remote computer; determining that the task is to access a memory address of the remote computer; ***executing the task at the remote computer using the protocol*** independent of the operating system of the remote computer; and returning a response packet to the caller computer containing information regarding the outcome of the task” (emphasis added). Independent claims 23 and 27 include similar language. Support for these changes can be found in paragraphs [0033] – [0039] of Applicants’ Specification.

Applicants respectfully submit that *Tsai* in view of *Reasor* in further view of *Barnstijn* fails to teach each and every element of the claimed invention. For example, *Tsai* in view of *Reasor* in further view of *Barnstijn* fails to teach using a caller computer to determine whether there are different protocols on the remote computer that are available to perform a particular task. *Tsai* in view of *Reasor* in further view of *Barnstijn* also fails to teach performing the task using the protocol. *Tsai* in view of *Reasor* in further view of *Barnstijn* specifically fails to teach instructing the remote computer to access a memory access using the protocol (claim 14), to access data maintained in an EFI table using the protocol (claim 23), or to perform a protocol interface function using the protocol (claim 27). *Tsai* does not appear to determine available protocols on remote computers for performing tasks. The same is true for *Reasor* and *Barnstijn*. This element is missing from each reference thus from the combination of the references. Applicants respectfully submit that because *Tsai* in view of *Reasor* in further view of *Barnstijn* fails to disclose each and every element of claims 14, 23, and/or 27 *Tsai* in view of *Reasor* in further view of *Barnstijn* fails to render claims 14, 23, and/or 27 obvious. Because *Tsai* in view of *Reasor* in further view of *Barnstijn* fails to render claims 14, 23, and/or 27 obvious, Applicants respectfully submit that claims 14, 23, and/or 27 are patentable over *Tsai* in view of *Reasor* in further view of *Barnstijn*.

Claims 9-13 properly depend from claim 1 and are thus patentable for at least the same reasons that claim 1 is patentable. Claims 15-22 properly depend from claim 14 and are thus patentable for at least the same reasons that claim 14 is patentable. Claims 25-26 properly depend from claim 23 and are thus patentable for at least the same reasons that claim 23 is patentable. Claims 28-30 properly depend from claim 27 and are thus patentable for at least the same reasons that claim 27 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 9-23 and 25-30.

CONCLUSION

Applicants respectfully submit that all grounds for rejection have been properly traversed, accommodated, or rendered moot and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

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I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below.

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